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OFFICE OF PETITIONS

In re Application of :
Swift et al. : DECISION ON
Application No. 09/847,960 : PETITION
Filed: May 2, 2001 :
Atty Docket No. A-69332-1/RMS :
/JJD :

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT" filed November 23, 2004. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from three hundred eight (308) days to three hundred thirty (330) days.

The application for patent term adjustment is **DISMISSED**.

For the reasons set forth herein, the Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **two hundred eighty-three (283)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On August 24, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 308 days. On November 23, 2004, applicants timely¹ submitted an application for patent term adjustment (with required fee). Applicants dispute the

¹ PALM records indicate that the Issue Fee payment was also received on November 23, 2004.

reduction of 27 days associated with their delay in responding to the Notice to File Missing Parts mailed July 13, 2001. Applicants state that their response was received on October 18, 2001 and thus, the delay should only be 5 days.

The record supports a conclusion that the patent issuing from the application is not subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of three hundred eight (308) days based on an adjustment for PTO delay of three sixty-five (365) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) reduced by applicants' delays of twenty-seven (27) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and thirty (30) days for delay in replying to the Notice to File Missing Parts of Application mailed July 13, 2001, and the final rejection mailed March 19, 2004, respectively. The period of reduction of 27 days is at issue.

A review of the application file reveals that the applicants' response to the Notice to File Missing Parts of Application mailed July 13, 2001, is of record in the application with a date of receipt by the Office of August 27, 2001. However, this response was not complete. The Notice required applicants to submit *inter alia* substitute drawings. The Office mailed a Notice of Incomplete Reply on September 7, 2001, notifying applicants that their response received August 27, 2001 was incomplete and requesting the substitute drawings. On October 18, 2001, applicants supplied the substitute drawings.

Pursuant to 37 CFR 1.704(c)(7), applicants failed to engage in reasonable efforts to conclude prosecution of the application by submitting an incomplete reply to the request for substitute drawings set forth in the Notice to File Missing Parts of Application mailed July 13, 2001. 37 C.F.R. § 1.704(c)(7) provides that:

Submission of a reply having an omission (§1.135(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed.

In the instant case, an initial reply was filed on August 27, 2001. However, by Notice mailed September 7, 2001, applicants

were advised that the reply was not complete. On October 18, 2001, applicants filed another response. Accordingly, the period of adjustment is 52 days, the number of days in the period beginning on August 28, 2001 and ending on October 18, 2001.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is two hundred eighty-three (283) days. $(365 - (52 + 30))$.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Patent Publication so that a patent can be issued.

Telephone inquiries specific to this decision should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

*Karin A. Ferriter
for*

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Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Revised PAIR Screen